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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,924	08/12/2004	Theresa F. Steiger	13213-107001	4923
26191	7590	05/17/2006	EXAMINER	
FISH & RICHARDSON P.C.			AUSTIN, AARON	
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MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	

1775

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,924	Applicant(s) STEIGER ET AL.	
	Examiner Aaron S. Austin	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004 and 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-37 and 40-43 is/are rejected.
- 7) ☒ Claim(s) 27, 32, 33, 38-40 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 27 is objected to because of the following informalities: "wherein the article" should read "wherein the fabric article" to conform with the rest of the claims. Appropriate correction is required.

Claim 33 is objected to because of the following informalities: the claim is missing a period. Appropriate correction is required.

Claims 32 and 33 are objected to because of the following informalities: "plurality first magnetically attractable devices" should read "plurality of first magnetically attractable devices". Appropriate correction is required.

Claim 40 is objected to because of the following informalities: "An Christmas decoration" should read "A Christmas decoration". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-29 and 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelarde (US Patent No. 7,017,292) in view of art incorporated by reference including Malino (US Patent No. 5,799,423), and further in view of Tate (US Patent No. 5,996,116).

Abelarde teaches a countdown calendar having a theme, such as for Christmas or other holiday. The calendar includes a planar substrate formed of fabric or similar sheet material having a design portion and a date portion (column 2, lines 62-65). The substrate is marked with indicia/countdown labels in the form of various pictorial or text features in the design and date portions (column 4, lines 46-47). Number coded target locations and date locations are provided (column 3, lines 16-28). The design of the substrate may be that of a Christmas tree and may include a plurality of marker elements in the form of decorative ornaments (column 3, line 4 and Fig. 6). The marker elements may be removably secured to the target and date locations by magnets, hook and loop fasteners, non-hardening adhesive, etc. (column 2, line 5). Methods for magnetic attachment are taught through incorporation by reference (column 2, lines 8-11). In particular, Malino teaches embedding individual magnet devices in a magnetic piece (Fig. 4B) for removable attachment to a non-ferromagnetic body portion of a calendar. Cavities or recesses may be used as storage compartments for receiving the marker elements (column 4, lines 50-58).

Abelarde does not teach a plurality of magnetic devices aligned with the indicia. Further, the fabric article is not taught as including a front panel and a rear panel.

Tate teaches incorporation of multiple magnets at desired intervals between front and rear layers of a fabric article at locations desirable for magnetic attachment of another article (column 5, lines 19-47 and Fig. 4). Therefore, as Tate teaches a plurality of magnetic devices disposed between front and rear layers of a fabric article provides the advantage of locating magnetic material at desired locations along a fabric article, it

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would have been obvious to one of ordinary skill in the art at the time of the claimed invention to locate magnetic devices at the number coded target locations and date locations by placement of a plurality of magnetic devices in alignment with the locations fixated in place using front and rear panels of the fabric article taught by Abelarde. Thus the claimed invention as a whole is *prima facie* obvious over the combined teachings of the prior art.

Further, regarding claim 23, Abelarde in view of Malino discloses the claimed invention except for a plurality of magnetic devices aligned with the indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the non-ferromagnetic body portion of the calendar of a plurality of magnetic devices aligned with the indicia, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claims 28 and 29, Abelarde does not specifically teach the storage recesses being defined by a fabric article. However, as Abelarde teaches storage recesses provide the benefit of storing the marker elements, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include storage recesses with the fabric article taught by Abelarde.

Regarding claims 32 and 33, Abelarde teaches a magnet which includes rare earth magnets. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a rare earth magnet as the magnet of Abelarde, since it has been held to be within the general skill of a worker in the art to

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select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416.

Claims 30 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abelarde (US Patent No. 7,017,292) in view of Tate (US Patent No. 5,996,116), and further in view of Malino (US Patent No. 5,799,423).

Abelarde teaches a countdown calendar as described above.

Abelarde does not teach a hanger member coupled to the calendar.

Malino teaches use of magnetic strips, jagged member, or other suitable hanger for hanging of a calendar (column 5, line 2 and Figs. 9 and 10). Therefore, as Malino clearly teaches use of a hanger member provides the benefit of permitting hanging of a calendar, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a hanger member with the calendar taught by Abelarde. Thus the claimed invention as a whole is *prima facie* obvious over the combined teachings of the prior art.

Regarding claim 40, Abelarde does not specifically teach the storage recesses being defined by a fabric article. However, as Abelarde teaches storage recesses provide the benefit of storing the marker elements, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include storage recesses with the fabric article taught by Abelarde.

Regarding claim 42, Abelarde teaches a magnet that includes rare earth magnets. Further, it would have been obvious to one having ordinary skill in the art at

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the time the invention was made to use a rare earth magnet as the magnet of Abelarde, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering choice. *In re Leshin*, 125 USPQ 416.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abelarde (US Patent No. 7,017,292) in view of Tate (US Patent No. 5,996,116), and further in view of Malino (US Patent No. 5,799,423) and Davis et al. (US Patent Application Publication No. 2004/0079005).

Abelarde teaches a countdown calendar as described above.

Abelarde does not teach a hanger member comprising a loop member.

Davis et al. teach a calendar/chart including loops that provide a versatile hanging configuration (paragraph [0018]). Therefore, as it is clearly taught by Davis et al. that a hanger member comprising a loop provides the advantage of a versatile hanging configuration, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a loop member for hanging the calendar taught by Abelarde.

Allowable Subject Matter

Claims 38, 39, and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or provide motivation for a decoration device comprising the elements and their structural relationship as claimed in claims 38, 39, and 44. Specifically, the prior art fails to teach a decoration device comprising a decorative ornament or fabric article including an audio device, light emitting device, or vibratory device in combination with a fabric article, a plurality of magnetically attractable devices, a plurality of indicia coupled to the fabric article, and a plurality of decorative ornaments including a second magnetically attractable device.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron S. Austin whose telephone number is (571) 272-8935. The examiner can normally be reached on Monday-Friday: 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASA


JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
5/12/06